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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,193	08/23/2001	Larry C. Gundlach	GUND-06195	1145

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EXAMINER

BECKER, DREW E

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,193

Applicant(s)

GUNDLACH ET AL.

Examiner

Drew E Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16, drawn to an apparatus, classified in class 99, subclass 533.
 - II. Claims 17-27, drawn to a method of injecting meat, classified in class 426, subclass 506.
 - III. Claim 28, drawn to a meat product, classified in class 426, subclass 645.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus of group I as claimed can be used to practice another and materially different process, for instance treating materials other than meat.
3. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product of group III as claimed can be made by another and materially different process, for instance by vacuum tumbling the meat rather than using injection of the fluid.

4. Inventions I and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus, for instance a vacuum tumbler can be substituted for the injector.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-III, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with J. Mitchell Jones, a provisional election was made without traverse to prosecute the invention of group II, claims 17-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-16 and 28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

10. Applicant is advised that should claims 18-19 be found allowable, claims 25-26 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 17-19, 21, 23, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higashimoto [Pat. No. 4,881,458] in view of Buller-Colthurst [Pat. No. 4,751,092].

Higashimoto teaches a method of treating meat by providing a meat product and injection solution (column 1, lines 8-10), injecting the brine solution into the meat by use of a manifold (Figure 1, #3; column 2, line 40), mechanically treating the meat with piston-driven planar surface (Figure 1, #21), and the solution inherently being partly expelled when pressed. Higashimoto does not teach hanging the meat and the use of pork bellies. Buller-Colthurst teaches a method of treating meat by hanging pork bellies on hooks (column 3, line 63; column 7, lines 11-29). It would have been obvious to one of ordinary skill in the art to incorporate the hooks and pork bellies of Buller-Colthurst into the invention of Higashimoto since both are directed to methods of treating meats, since Higashimoto already included the use of ham (column 1, line 14), since pickled meats were commonly hung on hooks in order to cure, as shown by Buller-Colthurst (column 3, line 53), and since pork bellies were a commonly pickled type of meat.

13. Claims 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higashimoto in view of Raevsager [Pat. No. 5,881,640].

Higashimoto teaches a method of treating meat by providing a meat product and injection solution (column 1, lines 8-10), injecting the brine solution into the meat by use of a manifold (Figure 1, #3; column 2, line 40), mechanically treating the meat with piston-driven planar surface (Figure 1, #21), and the solution inherently being partly

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expelled when pressed. Higashimoto does not teach recovering and reusing the injection solution. Raevsager teaches a method of recovering and reusing injection solution (column 3, lines 5-14). It would have been obvious to one of ordinary skill in the art to incorporate the recovery and reuse of Raevsager into the invention of Higashimoto since both are directed to methods of treating meat, since Higashimoto already included injection of brine solution and pressing (Figure 1, #1 & 21) which would have inherently caused the release of excess solution, and since the recovery and reuse of solution by Raevsager would have provided reduced consumption of solution and thereby reduced operating costs.

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Higashimoto, in view of Buller-Colthurst, as applied above, and further in view of Raevsager.

Higashimoto and Buller-Colthurst teach the above mentioned concepts. Higashimoto and Buller-Colthurst do not teach recovering and reusing the injection solution.

Raevsager teaches a method of recovering and reusing injection solution (column 3, lines 5-14). It would have been obvious to one of ordinary skill in the art to incorporate the recovery and reuse of Raevsager into the invention of Higashimoto since both are directed to methods of treating meat, since Higashimoto already included injection of brine solution and pressing (Figure 1, #1 & 21) which would have inherently caused the release of excess solution, and since the recovery and reuse of solution by Raevsager would have provided reduced consumption of solution and thereby reduced operating costs.

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15. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Higashimoto, in view of Buller-Colthurst, as applied above, and further in view of Klaassen [Pat. No. 5,176,071].

Higashimoto and Buller-Colthurst teach the above mentioned concepts. Higashimoto and Buller-Colthurst do not teach a roller bar. Klaassen teaches a method of compressing meat via a roller bar (Figure 1, #5). It would have been obvious to one of ordinary skill in the art to incorporate the roller bar of Klaassen into the invention of Higashimoto, in view of Buller-Colthurst, since all are directed to methods of treating meat, since Higashimoto already included a pressing device (Figure 1, #21), and since the roller bar of Klaassen would have provided a less complicated and more reliable means of fully pressing the meat.

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bifulco [Pat. No. 6,601,499], Greenspan et al [Pat. No. 3,719,504], Basile et al [Pat. No. 6,497,176], Pedersen [Pat. No. 3,615,704], Schack et al [Pat. No. 3,661,073], Kudale et al [Pat. No. 3,739,713], and Ludwig et al [Pat. No. 5,972,398] teach methods of injecting, pressing meat, and recycling solution.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Thur. 8am-5pm and every other Fri. 8am-4pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0987.



Drew E Becker
Primary Examiner
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1-23-04